

## **REMARKS**

**[0001]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 4-9, 14-23, 25-27, 29, 30 and 34-42 are presently pending. Claims amended herein are 1, 27, 30 and 38. Claims cancelled herein are 10-13 and 33. New claims added herein are 39-42.

### **Claim Amendments**

**[0002]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 27, 30, and 38 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

**[0003]** Claim 1 is amended to include subject matter from dependent claims 10 and 38.

**[0004]** Claim 27 is amended to include subject matter from claims 10 and 38.

**[0005]** Claim 30 is amended to include subject matter from claims 10 and 38.

**[0006]** New claims 39-42 include subject matter from claims 38. These claims simply claim individual characteristics originally claimed in independent claim 38 respectively.

## **Substantive Matters**

### **Claim Rejections under §103**

**[0007]** The Examiner's rejections are based upon the following references in combination:

- **Novak:** *Novak, et al.*, US Patent Application Publication No. 2003/0126599 (published July 3, 2003);
- **Gatto:** *Gatto, et al.*, US Patent No. 7,346,917 (issued March 18, 2008);
- **Vallon:** *Vallon, et al.*, US Patent No. 6,642,939 (issued November 4, 2003);
- **Lu:** *Lu, et al.*, US Patent No. 6,647,548 (issued November 11, 2003);
- **Griencewic:** *Griencewic*, US Patent No. 6,320,591 (issued November 20, 2001);
- **Bedard:** *Bedard*, US Patent No. 5,805,235 (issued September 8, 1998);
- **Vasilevsky:** *Vasilevsky, et al.*, US Patent Application Publication No. 2005/0166258 (published July 28, 2005); and
- **Carver:** *Carver, et al.*, US Patent No. 7,451,467 (issued November 11, 2008).

**[0008]** Claims 1, 4-6, 10-11, 14-23, 25-27, 29-30 and 33 under 35 U.S.C. §103(a) as being unpatentable over Novak in view of Gatto.

**[0009]** Claims 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Vallon.

**[0010]** Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Lu.

**[0011]** Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Griencewic.

**[0012]** Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Bedard.

**[0013]** Claims 34-36 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Vasilevsky.

**[0014]** Claim 37 is rejected under 35 U.S.C. §103(a) as being unpatentable over Novak and Gatto in further view of Carver.

**[0015]** In light of the amendments presented herein, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

## **Obviousness Rejections**

### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

[0016] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met for each claim as presently amended.

### **Independent Claim 1**

[0017] Applicant submits that the combination of cited art does not teach or suggest at least the following features as recited in this claim as presently amended (with emphasis added):

- "wherein at least one of said adding the mark and said presenting the information via the second processing mechanism comprises displaying a visual indicator of the mark at a display position that is related to a time at which the mark was associated with the information, **wherein the visual indicator of the mark comprises visual display properties that convey at least one characteristic of the mark, wherein said at least one characteristic of the mark comprises a time when the mark was created**"

[0018] The Examiner indicates (Action, p.18, in rejecting dependent claim 38) the following with regard to this claim element:

With regard to claim 38, Novak in view of Gatto discloses the method of claim 10 by displaying a mark with a characteristic, such as a color pertaining to a particular actress. However they fail to disclose wherein at the least one characteristic of the mark is selected from a group of characteristics consisting of an indication of a user who created the mark. Vasilevsky discloses that a user can see what marks other users have made (see figure 7 and corresponding paragraph [0058]). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Vasilevsky to the system of Novak in view of Gatto in that it would be advantageous to see what bookmarks other users have placed in order to more quickly identify content of interest.

**[0019]** Applicant respectfully traverses the Examiner's contention that the combination of cited art teaches that a user can see what other marks other users have made, but in an attempt to advance prosecution, Applicant has amended independent claim 1 to specify that the characteristic of the mark comprises "a time when the mark was created." (See independent claim 1). These elements and features were originally claimed by dependent claim 38. The Examiner has not pointed out where this claim element is taught in the references of record. Applicant would respectfully contend that the Examiner has not pointed out specific portions of the art of record as the art of record does not teach or suggest this element.

[0020] As such, the combination of cited art does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

#### **Dependent Claims 4-9, 14-23, 25-26 and 34-42**

[0021] These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

#### **Independent Claim 27**

[0022] Applicant submits that the combination of cited art does not teach or suggest at least the following features as recited in this claim as presently amended (with emphasis added):

- “a selectable command to create a mark associated with the first program, wherein the mark comprises a visual indicator of the mark at a display position that is related to a time at which the mark is associated with information, wherein the visual indicator of the mark comprises visual display properties that convey at least one characteristic of the mark, **wherein said at least one characteristic of the mark comprises a time when the mark was created;**”

[0023] The Examiner indicates (Action, p.18, in rejecting dependent claim 38) the following with regard to this claim element:

With regard to claim 38, Novak in view of Gatto discloses the method of claim 10 by displaying a mark with a characteristic, such as a color pertaining to a particular actress. However they fail to disclose wherein at the least one characteristic of the mark is selected from a group of characteristics consisting of an indication of a user who created the mark. Vasilevsky discloses that a user can see what marks other users have made (see figure 7 and corresponding paragraph [0058]). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Vasilevsky to the system of Novak in view of Gatto in that it would be advantageous to see what bookmarks other users have placed in order to more quickly identify content of interest.

**[0024]** Applicant has amended independent claim 27 to specify that the characteristic of the mark comprises "a time when the mark was created." (See independent claim 1). These elements and features were originally claimed by claim 38. The Examiner has not pointed out where this claim element is taught in the references of record. Applicant would respectfully contend that the Examiner has not pointed out specific portions of the art of record as the art of record does not teach or suggest this element.

**[0025]** As such, the combination of cited art does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claim 29**

[0026] This claim ultimately depends upon independent claim 27. As discussed above, claim 27 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Independent Claim 30**

[0027] Applicant submits that the combination of cited art does not teach or suggest at least the following features as recited in this claim as presently amended (with emphasis added):

- “marking logic, stored in the first memory and executed by the first processor to create a mark associated with information currently being presented, wherein the mark is embedded in the information and **comprises a visual indicator of the mark at a display position that is related to a time at which the mark is associated with information, wherein the visual indicator of the mark comprises visual display properties that convey at least one characteristic of the mark, wherein said at least one characteristic of the mark comprises a time when the mark was created;**”

[0028] The Examiner indicates (Action, p.18, in rejecting dependent claim 38) the following with regard to this claim element:



With regard to claim 38, Novak in view of Gatto discloses the method of claim 10 by displaying a mark with a characteristic, such as a color pertaining to a particular actress. However they fail to disclose wherein at the least one characteristic of the mark is selected from a group of characteristics consisting of an indication of a user who created the mark. Vasilevsky discloses that a user can see what marks other users have made (see figure 7 and corresponding paragraph [0058]). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Vasilevsky to the system of Novak in view of Gatto in that it would be advantageous to see what bookmarks other users have placed in order to more quickly identify content of interest.

**[0029]** Applicant has amended independent claim 30 to specify that the characteristic of the mark comprises “a time when the mark was created.” (See independent claim 1). These elements and features were originally claimed by claim 38. The Examiner has not pointed out where this claim element is taught in the references of record. Applicant would respectfully contend that the Examiner has not pointed out specific portions of the art of record as the art of record does not teach or suggest this element.

**[0030]** As such, the combination of cited art does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

## **Conclusion**

[0031] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

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